

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Mailed:
May 24, 2005

Grendel

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Allergan, Inc.
v.
Solux Corporation

Opposition No. 91156142
to application Serial No. 78144461
filed on July 16, 2002

Kenneth L. Wilton of Seyfarth Shaw for Allergan, Inc.
Solux Corporation, pro se.

Before Seeherman, Quinn and Grendel,¹ Administrative
Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant, Solux Corporation, seeks registration on the
Principal Register of the mark LIPOTOX (in typed form) for
goods identified in the application as "pharmaceutical
preparations for the treatment of neurological disorders,
muscle dystonias, smooth muscle disorders, autonomic nerve
disorders, headaches, wrinkles, hyperhydrosis, sports

¹ Formerly known as Bottorff.

Opposition No. 91156142

injuries, cerebral palsy, spasms, tremors and pain," in Class 5.²

Opposer, Allergan, Inc., filed a timely notice of opposition to registration of applicant's mark. As its ground for opposition, opposer alleges that applicant's mark, as applied to the goods identified in the application, so resembles opposer's previously-used and registered mark BOTOX as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d). In the notice of opposition, opposer pleaded ownership of three registrations of the mark BOTOX, Registration Nos. 1692384, 1709160 and 2510675.

Applicant answered the notice of opposition by denying the salient allegations thereof.

At trial, opposer submitted evidence (discussed below), but applicant did not. Opposer and applicant submitted main briefs and opposer submitted a reply brief. No oral hearing was requested.

With its reply brief, opposer filed a motion to strike certain factual assertions made by applicant in applicant's brief as well as an exhibit attached to applicant's brief, on the ground that these statements and the attachment are

² Application Serial No. 78144461, filed on July 16, 2002. The application is based on applicant's asserted bona fide intention to use the mark in commerce. Trademark Act Section 1(b), 15 U.S.C. §1051(b).

Opposition No. 91156142

not supported by the evidence of record. We grant opposer's motion to strike insofar as it pertains to the factual assertions applicant has made in its brief. No evidence in the record supports these assertions, and we therefore have given them no consideration. See TBMP §704.06(b) (2d ed. rev. 11/04). However, we deny opposer's motion to strike insofar as it pertains to the exhibit attached to applicant's brief, i.e., the listing of alleged third-party "TOX" marks. The same listing was attached to applicant's answer to opposer's Interrogatory No. 7, and that answer and its attachment were made of record by opposer via notice of reliance. We therefore decline to strike the exhibit from applicant's brief.³

The evidence of record consists of the pleadings herein, the file of the opposed application, and the evidence submitted by opposer via notice of reliance, i.e., certain of opposer's discovery requests and applicant's responses thereto, and status and title copies of opposer's three pleaded registrations.⁴ The three pleaded registrations, which are extant and owned by opposer, are:

³ However, as discussed *infra*, we have given no probative value to this mere listing of alleged third-party marks.

⁴ Opposer also submitted status and title copies of a fourth registration, Registration No. 2510673. However, this registration was not pleaded in the notice of opposition, nor did opposer move to amend the pleading to add an allegation of ownership of such registration. We therefore have given no consideration to this unpleaded registration. We note, however, that this unpleaded registration is merely cumulative in any

Opposition No. 91156142

- Registration No. 1692384, which is of the mark BOTOX (in typed form) for "pharmaceutical preparations; namely, ophthalmic muscle relaxants," in Class 5;

- Registration No. 1709160, which is of the mark BOTOX (in typed form) for "pharmaceutical preparations for the treatment of neurologic disorders," in Class 5; and

- Registration No. 2510675, which is of the mark BOTOX (in typed form) for "pharmaceutical preparations for the treatment of neurological disorders, muscle dystonias, smooth muscle disorders, autonomic nerve disorders, headaches, wrinkles, hyperhydrosis, sports injuries, cerebral palsy, spasms, tremors and pain," in Class 5.

Because opposer has proven the status and title of its pleaded registrations, we find that opposer has established its standing to oppose registration of applicant's mark.

See Lipton Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). In addition, because opposer's pleaded registrations are of record, Section 2(d) priority of use is not an issue in this case. *See King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

event, inasmuch as the mark depicted therein is a stylized version of the BOTOX mark which is depicted in typed form in opposer's three pleaded registrations, and the goods identified in the unpleaded registration are the same as the goods identified in pleaded Registration No. 2510675.

Opposition No. 91156142

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We find, first, that applicant's goods are legally identical or highly similar to the goods identified in each of opposer's three registrations. Indeed, applicant's identification of goods is identical to the identification of goods in opposer's Registration No. 2510675; applicant has admitted that it copied opposer's identification of goods verbatim in drafting its own identification of goods. (Applicant's answers to opposer's Requests for Admission Nos. 4 and 5.) Because the parties' goods are legally identical, we also find that the trade channels for such goods and the classes of purchasers for such goods are legally identical. Thus, the second, third and fourth *du Pont* factors weigh in opposer's favor in this case.

Opposition No. 91156142

The fifth *du Pont* factor requires us to consider evidence of the fame of opposer's BOTOX mark, and to give evidence of such fame, if present, dominant weight in our likelihood of confusion analysis. See *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); and *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). In this case, there is no evidence in the record to support a finding that opposer's mark is famous, for purposes of the fifth *du Pont* factor.

Applicant has admitted that opposer's mark is "well-known" in the United States. (Applicant's answer to opposer's Request for Admission No. 3.) However, applicant denied opposer's request for an admission that opposer's mark is "famous" in the United States. (Applicant's answer to opposer's Request for Admission No. 2.) Opposer therefore was on notice that if it wished to assert and rely on the fame of its mark in this proceeding as contemplated by case law, proper evidence of such fame had to be submitted at trial. Opposer submitted no such evidence, i.e., sales figures, advertising expenditures, etc.

A "well-known" mark is not the same as a "famous" mark, nor is a "well-known" mark entitled to the same level of protection that a famous mark receives. The cases cited by

Opposition No. 91156142

opposer, in which marks proven to be famous are accorded a broad scope of protection, therefore are inapposite in this case, where opposer has proven only that its mark is "well-known." We therefore find that the fifth *du Pont* factor weighs in opposer's favor in this case, but only slightly, and certainly not to the extent it would have if opposer had presented evidence sufficient to establish that its mark is famous.

There is no evidence pertaining to the sixth *du Pont* factor, i.e., the number and nature of similar marks in use on similar goods. The list of alleged third-party marks attached to applicant's answer to opposer's Interrogatory No. 7 (made of record by opposer) is not evidence that the marks depicted therein are in use or that they are known to purchasers in this country. See, e.g., *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 74 USPQ2d 1689 (Fed. Cir. 2005). The sixth *du Pont* factor weighs in opposer's favor.

We turn finally to the first *du Pont* factor, i.e., whether applicant's mark, LIPOTOX, and opposer's mark, BOTOX, are similar or dissimilar when compared in their entirety in terms of appearance, sound, connotation and commercial impression. We make this determination in accordance with the following principles.

Opposition No. 91156142

The test, under the first *du Pont* factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entirety, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Finally, in cases such as this, where the applicant's goods are identical to the opposer's goods, the degree of similarity between the marks which is required to support a finding of likelihood of confusion is less than it would be if the goods were not identical. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

After careful review of the marks involved in this case, we find that applicant's mark is dissimilar rather

Opposition No. 91156142

than similar to opposer's mark. Indeed, for the reasons discussed below, we find that the marks are so dissimilar that confusion is unlikely to result even from use of the marks on identical goods.

In terms of appearance, we find that the marks are more dissimilar than similar. Opposer's mark has five letters and thus is shorter than applicant's mark, which has seven. Both marks end with the letters -TOX, but applicant's mark begins with the letters LIPO- and opposer's mark with the letters BO-. Overall, the marks are not confusingly similar in terms of appearance.

In terms of pronunciation, the marks are similar to the extent that the second and third syllables of applicant's mark, -POTOX, would be pronounced similarly to opposer's mark, BOTOX. However, applicant's mark has an additional syllable, LI-, at the start of the mark. Whether that syllable is pronounced with a long or a short "i," it would not be elided by purchasers but instead would be pronounced clearly; indeed, the first syllable is likely to receive the most stress of any of the syllables in applicant's mark. Its presence at the very beginning of the mark gives applicant's mark an overall three-syllable pronunciation which is readily distinguishable from the two-syllable pronunciation of opposer's mark.

Opposition No. 91156142

In terms of connotation, we find that the marks are quite dissimilar when viewed in their entireties. Opposer's mark, on this record, appears to be a coined term with no overall meaning, but which, with its -TOX suffix, suggests that the goods utilize or involve a toxin. We take judicial notice that "tox-," when used as a prefix, denotes "poison" or "poisonous," and that "toxin" is defined as "a poisonous substance, especially a protein, that is produced by living cells or organisms and is capable of causing disease when introduced into the body tissues but is often also capable of inducing neutralizing antibodies or antitoxins." The American Heritage Dictionary of the English Language (3d ed. 1992) at 1895.⁵ The letters BO- in opposer's mark appear on this record to be without meaning as applied to opposer's goods, as those goods are identified in opposer's registrations.⁶

Applicant's mark LIPOTOX shares the same suffix as opposer's mark, -TOX, and thus the same connotation, i.e., that the goods utilize or involve a toxin. However,

⁵ The Board may take judicial notice of dictionary definitions. See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

⁶ Applicant argues that purchasers would readily perceive that opposer's mark is a combination or telescoping of the terms "botulinum" and "toxin," because opposer's goods in fact are derived from the botulinum toxin. However, the record does not support applicant's contention. Opposer's goods, as identified in the registrations, are not defined or limited in this manner.

applicant's mark begins with what would readily be recognized as the prefix "lipo-." We take judicial notice that "lipo-" is defined as a prefix meaning "fat; fatty; fatty tissue." The American Heritage Dictionary of the English Language (3d ed. 1992) at 1048. Purchasers would readily recognize this prefix because of its presence in other commonly used words, most notably "liposuction."⁷ Thus, applicant's mark connotes that applicant's goods involve fat or fatty tissue, as well as a toxin or toxins. Although opposer's mark also has a "toxin" connotation, it is dissimilar to applicant's mark because it does not connote anything pertaining to "fat" or "fatty tissue."

We are not persuaded by opposer's argument that the marks are similar because they both have -OTOX as a suffix. -OTOX is not a suffix in either of these marks.⁸ -OTOX is not a suffix in opposer's mark, because it is not appended to a word or a word stem, but simply to the letter "B." If opposer's mark has a suffix, it is -TOX, appended to the apparently arbitrary syllable BO. Likewise, applicant's

⁷ We take judicial notice that "liposuction" is defined as "[a] usually cosmetic surgical procedure in which excess fatty tissue is removed from a specific area of the body, such as the thighs or abdomen, by means of suction." The American Heritage Dictionary of the English Language (3d ed. 1992) at 1048.

⁸ We take judicial notice that "suffix" is defined as "[a]n affix appended to the end of a word or stem, serving to form a new word or functioning as an inflectional ending, as *-ness* in *gentleness*, *-ing* in *walking*, or *-s* in *sits*." (Webster's II New Riverside University Dictionary (1984) at 1158.

Opposition No. 91156142

mark clearly would be perceived as consisting of a prefix, LIPO-, and a suffix, -TOX.

Considering the parties' marks in their entirety, we find that they are similar only in that they share the suffix -TOX, which if not descriptive is at least highly suggestive of a quality of the parties' respective goods, i.e., that they utilize or involve a toxin. Given the very different manners in which the respective marks begin, i.e., BO- and LIPO-, the fact that both marks share the suggestive suffix -TOX is not sufficient to support a finding that the marks as a whole are similar. The first *du Pont* factor therefore weighs in applicant's favor in our likelihood of confusion analysis.

Considering all of the evidence as it pertains to the various *du Pont* factors, we find that applicant's mark is so dissimilar to opposer's mark that no confusion is likely to result from the parties' contemporaneous use of the marks, even on legally identical goods marketed in the same trade channels to the same classes of purchasers. Opposer has not proved that its BOTOX mark is famous, and the mark therefore is not entitled to the broad scope of protection that a famous mark would receive. On this record, we find that the shadow of opposer's mark is not so long as to preclude registration of applicant's quite dissimilar mark. Rather, we find that the first *du Pont* factor is dispositive in this

Opposition No. 91156142

case. See *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

Decision: The opposition is dismissed.⁹

⁹ We note that applicant's involved application also is involved in a second opposition proceeding, Opposition No. 91157219, wherein Pfizer Inc., et al, are the opposers. That opposition has been suspended at the parties' request pending the outcome of the present proceeding.